

R E M A R K S

Claims 1-21 are pending in this application. In the office action mailed September 26, 2003:

- 1) claims 12-15 and 21 were objected to under 37 C.F.R. § 1.75(c) (office action, ¶ 3);
- 2) claims 1, 3-8, 16, 17, 19, and 20 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,056,204 (Bartschi) (office action, ¶ 4); and
- 3) claims 2, 9-11, and 18 were rejected under 35 U.S.C. § 103(a) as being obvious in view of Bartschi (office action, ¶ 5).

Additionally, suggested guidelines for the layout of a patent application is set forth in ¶ 2. Reconsideration is respectfully requested.

Layout of the Patent Application (office action, ¶ 2)

The applicants prefer the arrangement presented upon filing and submit that the application as filed complies with 35 U.S.C. § 112, ¶ 1.

Objection to the Claims (office action, ¶ 3)

Claims 12-15 and 21 were objected to under 37 C.F.R. § 1.75(c) as failing to further limit the subject matter of a previous claim. The independent claims have been amended to recite the term "fabricating" and therefore the applicants submit that the claims now comply with § 1.75(c).

Rejection under 35 U.S.C. § 102(b) (office action, ¶ 4)

Claims 1, 3-8, 16, 17, 19, and 20 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,056,204 (Bartschi). The claims are not anticipated by Bartschi as the reference fails to disclose all of the claimed elements. With regard to the independent claims 1, 16, and 17, the reference does not disclose, teach, or suggest:

"creating a digital representation of a shell conforming to the digital representation of the ear canal and the outer ear as applicable ..." (claim 1); or

"modifying at least one physical dimension of at least a portion of the digital representation the shell..." (claim 16); or

"a processor for creating a digital representation of the shell that conforms to the scanned digital representation of the ear canal and the outer ear as applicable..."

(claim 17).

To sustain a rejection based on anticipation under 35 U.S.C. § 102, "the reference must teach every element of the claim." M.P.E.P. § 2131 (8th ed., rev. 1, February 2003), page 2100-70. The M.P.E.P. goes on to state "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," quoting Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Because Bartschi does not disclose, teach, or suggest the creation of a digital representation of the shell or the modification of such a representation, it does not anticipate the independent claims (1, 16, and 17). The dependent claims, further limiting the steps drawn to a virtual representation of the shell, are likewise not anticipated.

Rejection under 35 U.S.C. § 103(a) (office action, ¶ 15)


Claims 2, 9-11, and 18 were rejected under 35 U.S.C. § 103(a) as being obvious in view of Bartschi. This rejection cannot be maintained for the same reason as set forth above with respect to the rejection of claims 1 and 17 under § 102 -- the reference does not disclose, teach, or suggest the creation of a digital representation of the shell or the modification of such a representation. Since all of the claim limitations are not taught or suggested by the cited art, obviousness has not been established. M.P.E.P. § 2143.03 (8th ed., rev. 1, February 2003), p. 2100-128 ("[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art"), citing In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974) [emphasis in original]. Because the reference fails to teach all of the claimed elements, it does not support a finding of obviousness. Additionally, there is no suggestion or teaching in the reference to modify it in such a manner that would result in the claimed invention.

Conclusion

The applicants believes that it has responded to all of the issues raised in the office action and submit that all of the pending claims are allowable. Thus, it is respectfully requested that the examiner pass the application to allowance. The examiner is invited to call the undersigned if there are any questions concerning the application.

Dated: December 17, 2003

Respectfully submitted,


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